



Patent

Attorney's Docket No. 032592-003

12/29/03  
14  
Rela

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of )  
Avram GLAZER ) Group Art Unit: 2167  
Application No.: 09/545,875 ) Examiner: Joseph A. Fischetti  
Filed: April 7, 2000 ) Confirmation No.: 2172  
For: SYSTEM OF CONSISTENT )  
INTERNET WEB SITE BANNERS )  
THAT PROVIDE PORTAL-LIKE )  
FUNCTIONALITY )

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED  
DEC 12 2003  
GROUP 3600

Sir:

In response to the Office Action mailed August 1, 2003 (which restarted the period for responding to the Office Action dated June 30, 2003), reconsideration and allowance of the present application are respectfully requested.

Claims 1-14 and 43 are presently pending in the application. Claims 15-42 were withdrawn from consideration following a Restriction Requirement. Claim 43 was improperly withdrawn from consideration in the most recent Office Action. Because claim 43 depends from claim 1, and corresponds to the group I category of inventions identified in the Restriction Requirement included with the Office Action dated March 29, 2002, claim 43 should be considered with claims 1-14. Alternately, claim 43 should be treated as

a non-elected species which, upon an indication of allowance of generic claim 1, should be deemed allowable.

More particularly, on page 2 of the Office Action dated June 30, 2003, the Examiner asserted that newly submitted claim 43 "is directed to an invention that is independent or distinct from the invention originally claimed ...". However, the failure to consider claim 43 is improper. Claim 43 depends from independent claim 1. Claim 43 should, at the very least, be treated as a non-elected species which should be deemed allowable with claim 1.

In the last paragraph on page 2 of the Office Action, claims 1-15 are rejected under 35 U.S.C. §112, second paragraph based on an assertion that "the step of 'publishing' on a file server is recited". This objection is respectfully traversed. The misunderstanding over use of the term "publishing" in claim 1 may also have lead to the Examiner's misplaced reliance on the art cited in the Office Action to reject claim 1. As will be discussed later, none of the cited art teaches or suggests establishing a connection between a file published on a first file server with a web page published on a second file server for display at an Internet web site.

Applicant's specification describes exemplary embodiments wherein an entity can prepare and issue content onto a server (i.e., "publish" content) for subsequent display in a web page published by a different entity at a different location. An entity which makes content (e.g., a banner file or a web site) available on a server constitutes a "publishing" entity (see, for example, specification page 6, lines 14-24). In support of Applicants'

assertion that posting of information on a server constitutes "publishing" as an accepted term of art, reference is made to the Microsoft Windows 98 document attached hereto in "Attachment A" wherein "publishing" is described. Attachment A describes the posting of Web pages to an Internet site (see the first paragraph under the heading "Publish your pages with the Web Publishing Wizard"). Withdrawal of the objection to Applicant's using the term of art "publishing" in connection with placement of information on an Internet file server is therefore respectfully requested.

In the last sentence on page 2 of the Office Action, the Examiner asserts that "Since it is stated in applicant's comments that the connection is an exclusive connection, the word publishing, has not occurred." The Examiner's comments do not support the Examiner's objection. Applicant's claim encompasses publishing of information on a file server, so that the information can be accessed and displayed in a web page that is published by a different file server. Applicant's use of the accepted term of art "publishing" can not be considered indefinite.

The term of art "publishing" in claim 1, is accurate, definite and proper, and is consistent with the use of this term throughout the World Wide Web by those skilled in the art. Withdrawal of this objection is therefore requested. However, should the Examiner have suggestions for a different phraseology which shares the same scope and meaning as Applicant's chosen term of art, it is requested that Applicant's representative be contacted in an effort to resolve this issue.

On page 3 of the Office Action, claims 1-4, 6-8, and 10-14 are rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,185,587 (Bernardo et al). On page 4 of the Office Action, claims 1-4 and 6-14 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,141,010 (Hoyle). On page 5, claims 1-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Bernardo or the Hoyle patent in combination with the Examiner's assertion of "Official Notice". On page 6, claims 1-14 are rejected as being unpatentable over the combination of the Hoyle patent with U.S. Patent No. 6,317,784 (Mackintosh et al). All of the foregoing rejections are respectfully traversed, as none of the patents relied upon by the Examiner, considered individually, or in the combinations set forth in the Office Action, teach or suggest Applicant's invention as set forth in independent claim 1.

Applicant's Figure 1 shows an exemplary networked computer system wherein communication devices 10a-c are connected to servers 12a-n by a communication network 14 such as the Internet. An exemplary banner, comprising a portion of a web page published at one site receives content published at a different site as illustrated in Figure 2. In Figure 2, a web page 20 of web publisher ABC, Inc., whose web site may be hosted on a first server 12a, is illustrated. A banner 24 published on a different web site XYZ Corp., may be hosted on a different server 12c. Instructions within the code for web page 20 are used to display the banner, and include a reference to the source of information for the banner (e.g., an address associated with server 12c), at which a file containing additional code for specifying contents of the banner 24 are resident.

As shown in Figure 3, an exemplary banner can provide access to multiple different services and thereby function as a multi-site/multi-function portal for the user. As shown therein, the exemplary banner 24a includes a menu 30 for affording the user access to various categories of content available through the party which has acquired the right to display and control the contents of the banner.

The foregoing features are broadly encompassed by independent claim 1, which is directed to a method for providing multiple types of content for users of the Internet. Claim 1 recites a step of publishing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services. Claim 1 further recites establishing a connection between said file and at least one web page that is displayed at an Internet web site; and causing at least some of the contents of said file to appear within a banner whenever a user downloads said page from the display.

Exemplary embodiments of the present invention can provide numerous advantages that are not realized in the systems described by the documents relied upon by the Examiner. Exemplary embodiments provide a tool for building a network of interconnected Internet sites. By establishing connections between a file published on a file server and web pages displayed at multiple Internet web sites, multiple web pages displayed at multiple web sites can access common banner content. This can provide increased access to the banner content and decrease the access cost the various web page hosts incur for displaying the banner content. The banner content can include valuable information which numerous web page hosts would have an interest in displaying to attract

interest to their sites. For example, a virtual network of sites can be tied together using a common banner, thus increasing the value of all sites participating in the virtual network.

None of the documents relied upon by the Examiner are directed to the web site model described in Applicant's specification, such that these documents fail to teach or suggest Applicant's claim 1 combination of features. For example, none of the documents relied upon teach or suggest establishing a connection between a file published on at least one file server and at least one web page published by a different server and displayed at an Internet web site, such that contents of the file appear within a banner when a user downloads the web page. To the contrary, systems and methods described in the patents relied upon, at best, are directed to a transfer of information from a server to an end user (e.g., to the desktop computer of an end user), and are not directed to establishing a connection between at least one file and at least one file server with a web page displayed at an Internet web site.

The Bernardo patent is directed to a traditional software tool that can be used in a static system for creating a web site that can be transferred from a server to an end user. The tool includes a template that can be used to create a web site. A user selects a desired template for the web site to be constructed, and is then prompted through a series of views to populate the fields of the template. Fig. 4 of the Bernardo patent illustrates an exemplary view that is presented to a web site creator for use in creating a web site, and for causing contents of the file to appear within a banner whenever a user downloads the page for display.

The template stored in the database of Bernard's system is statically accessed and used interactively by a user to create the web page. A user must interact with the web server to access the database. Information is not automatically pulled down from third party servers using links; for the system of the Bernardo patent to provide such a capability, the user would have to recreate the website every time the third party server's database is to be changed.

Because the Bernardo patent is directed to a tool for creating a web site, this patent fails to teach or suggest the dynamic system recited in Applicant's claim 1 combination. For example, there is no teaching or suggestion in the Bernardo patent of establishing a connection between a file published on a file server and a web page displayed at an Internet web site so that files published by different servers can be interconnected. Referring to Fig. 2 of Bernardo, the tool is included in a server 30 which can access a database 40 containing a library of templates, views and fields (see column 6, lines 26-34). As described in the paragraph bridging columns 6 and 7, a web site creator can access the tool using a network browser resident on a client terminal to build up the web site.

While the tool of the Bernardo patent could, for example, be used to build a web site or could possibly be used to separately build a banner, there is no teaching or suggestion of establishing a connection between a web site and a separately published banner. Because information from the database 40 in Bernardo is merely used to create the web page, Bernardo teaches away from any need to "establish a connection" as recited in Applicant's claim 1, so that information in a file on a file server will appear within a banner of a web

page whenever a user downloads the page for display. Claim 1 is therefore allowable over the Bernardo patent.

Claim 1 is also allowable over the Hoyle patent. Referring to the Hoyle patent, the abstract describes providing an automatically upgradable software application that includes targeted advertising. The software application is described as a graphical user interface that includes a display region for banner advertising downloaded over the Internet. The software application is described as being accessible from the server via the Internet. According to the Hoyle patent, the user acquires software over the Internet, which then becomes resident on the user's machine. Banner advertising information can then be sent directly to the user. Thus, this patent is directed to an "executable" file which resides on a client's machine. Rather than establishing a connection between a file published on a separate server containing banner advertising and at least one web page displayed at an Internet web site, the Hoyle patent is directed to creating a direct link between an end user and an entity which provides banner advertising. The Hoyle patent fails to teach or suggest establishing a connection between a file and a web page displayed at an Internet web site, and causing contents of the file to appear within a banner whenever a user downloads the web page for display (Applicant's claim 1).

The foregoing distinction can be traced to a fundamental difference in the business model associated with the system of the Hoyle patent versus that of the present invention. In accordance with the Hoyle patent, end users constitute the customer base which would purchase the automatically upgradable software application that can communicate directly



with banner advertisers. In contrast, exemplary embodiments of the present invention are directed to web site owners interested in interfacing their web site with multiple types of content published on different servers to provide more content rich web pages to end users using a virtual network of sites.

The Mackintosh patent, which is relied upon on page 6 of the Office Action is directed to a media player for playing broadcast material and associated supplemental information. The player includes a receiver configured to receive broadcast material from a broadcast service provider. As with the Hoyle patent, the Mackintosh patent is directed to creating a direct link between a broadcaster and end users, and precludes end users from controlling the request for material from a file on a different server that is accessed via a web page downloaded by the user for display. Thus, the Mackintosh patent, even when considered in combination with the Hoyle patent, fails to teach or suggest establishing a connection between a file on at least one file server, and at least one web page that is displayed at an Internet web site, such that contents of the file appear within a banner downloaded by a user for display.

Because the patents relied upon by the Examiner fail to teach or suggest Applicant's claim 1 combination of features, this claim is considered allowable. The remaining claims 2-14 recite additional advantageous features of the present invention and further distinguish over the documents relied upon by the Examiner. Claim 15, which was included in the rejection under 35 U.S.C. §112, is also considered allowable.

In the August 1, 2003 Office Action, the Examiner has supplemented previous assertions of "Official Notice" by referring to newly cited patents. The Examiner has cited U.S. Patent No. 5,929,927 (Rumreich et al) as allegedly supporting the Examiner's "Official Notice" regarding "the old and notorious scrolling in claim 5 and the use of the search function in claim 9." The Examiner states: "For evidence of old and notr. scrolling, please see Rumreich et al." (see page 5 of the June 30, 2003 Office Action). In the last paragraph on page 5 of the Office Action, the Examiner states:

Official Notice is taken with respect to the old and notorious use of the providing headlines which are hyperlinked to a more detailed desription of the story as well as the use of scrolling as a form of viewing. Likewise, official notice is taken regarding the notoriously well known expedient of providing a community billboard posted at a web site. See, Merriman et al for old/notr. evidence of advertising with hyperlinks.

The rejections under 35 U.S.C. §103 based on the newly cited references to Rumreich and Merriman are respectfully traversed. Neither of these patents, even when considered in combination with the other cited patents, overcomes the deficiencies described above with respect to the Bernardo, Hoyle and/or Mackintosh patents. In addition, these two newly cited patents do not support the "Official Notice" asserted by the Examiner.

For example, the Rumreich patent is not directed to displaying individual headlines of a banner of a web page in a scrolling manner. To the contrary, the Rumreich patent is a hardware oriented approach that is directed to displaying text information automatically, using a hardware based system associated with, for example, the closed captioning used in

conjunction with a television program's audio content. Applicant's claim 5 depends from claims 1-4, and recites the displaying of individual headlines of a website banner in a scrolling manner. The Rumreich patent would have been inappropriate for combination with the other patents cited in the Office Action in the manner relied upon by the Examiner. However, even if any combination of features in the Rumreich patent with features set forth in the primary references would have been obvious to those skilled in the art, the presently claimed invention would not have resulted for reasons already discussed. Thus, the Rumreich patent would not support the assertion of "Official Notice" for which it is relied upon in the rejection of claim 5, and Rumreich fails to overcome the deficiencies of the primary references relied upon by the Examiner.

Similarly, the Merriman patent does not support the Examiner's assertion of Official Notice. The Merriman patent is directed to a method of delivering advertising information over a network. The Merriman patent simply discloses the well known use of a link on a displayed webpage to allow a user to navigate from one website to another. The Merriman patent does not teach or suggest Applicants' claim 7 feature whereby a displayed headline comprises a link to a file which contains content associated with the headline, and which is displayed to the user when the user clicks upon the headline while it is displayed. Merriman also fails to teach or suggest a link (claim 8) to cause all of the headlines associated with a selected category to be displayed for viewing by the user. Exemplary embodiments of the present invention allow details regarding a headline to be displayed within a window of a particular website, while the Merriman patent merely allows a user to

navigate from one website to another. The Merriman patent does not teach or suggest features recited in Applicants' dependent claims, and this patent does not support the Examiner's assertion of relies on "Official Notice". In addition, Merriman fails to overcome the already noted deficiencies of the primary references.

With respect to claim 9, the Examiner relies upon "Official Notice". However, neither the Merriman nor the Rumreich patent are cited as support for the Official Notice taken. Accordingly, it is respectfully requested that some form of support be provided for the Official Notice taken with respect to claim 9.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 1, 2003

By: 

Patrick C. Keane

Registration No. 32,858

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Enclosures: Attachment A "Web publishing wizardry" (3 pages)